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PATENT

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Attorney Docket
032405 WN 061

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	:	Hirofumi SAKAUE et al		
Serial No.	:	09/752,564	Examiner	: G. Strimbu
Filed	:	January 03, 2001	Art Unit	: 3634

For: REAR GATE OPENING AND CLOSING APPARATUS FOR VEHICLE

RESPONSE TO WRITTEN RESTRICTION REQUIREMENT

Commissioner for Patents
Washington, DC 20231

Sir :

A response to the Office Action of July 25, 2002 is due by August 26, 2002 (August 25, 2002 being a Sunday).

The Action required restriction between:

Group I of claims 1-13, drawn to a rear gate opening and closing apparatus; and

Group II of claims 14-16, drawn to a vehicle having an apparatus for opening and closing a rear gate of the vehicle.

Applicants hereby elect Group I, claims 1-13, for prosecution in this application. The election is made with traverse.

Applicants submit that the Restriction Requirement is improper. The M.P.E.P. states, "If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." M.P.E.P. § 803. Applicants submit that the previous Examiner examined all of the pending claims together, as evidenced by the conversation of May 2, 2002 between previous Examiner Cohen and Applicants' representative, which will be explained in greater detail below.

Thus, the Restriction Requirement is improper since examining all of the pending claims would not present a serious burden to the Examiner.

Now to turn to the Interview Applicants' representative had with the previous Examiner, Examiner Cohen, on May 2, 2002. As discussed in the Supplemental Amendment filed by Applicants on May 7, 2002, Examiner Cohen contacted Applicants' representative to propose amendments to the claims which, according to Examiner Cohen, would place the present application in condition for allowance. The amendments to the claims, which were suggested by Examiner Cohen, were submitted in the Supplemental Amendment filed on May 7, 2002. In other words, every change to the claims was suggested by Examiner Cohen and agreed upon during the telephone conversation of May 2, 2002. Applicants' note that the amendments were generally editorial in nature. Upon filing the Supplemental Amendment, Applicants assumed that the next communication from the U.S. PTO would be a Notice of Allowance.

However, Applicants received a Restriction Requirement dated July 16, 2002 requiring the election of one of two Groups as discussed above. Applicants representative contacted new Examiner Strimbu to discuss the Restriction Requirement. Examiner Strimbu indicated he could not give full faith and credit to the conversation of May 2, 2002 since neither the previous Examiner nor Applicant provided a summary of the conversation. Applicants submit that this is not only incorrect, but also improper.

Applicants submit that Examiner's conclusion is incorrect since Applicants did in fact provide a summary of the conversation in the Supplemental Amendment filed May 7, 2002. The Supplemental Amendment stated, "This Supplemental Amendment is also in response to a communication with the Examiner on May 2, 2002 wherein claim amendments were suggested for

In addition, the Examiner's actions were improper according to U.S. PTO practice. The M.P.E.P. states:

> **When an examiner is assigned to act on an application which has received one or more actions by some other examiner, full faith and credit should be given to the search and action of the previous examiner unless there is a clear error in the previous action or knowledge of other prior art. In general the second examiner should not take an entirely new approach to the application or attempt to reorient the point of view of the previous examiner, or make a new search in the mere hope of finding something. MPEP § 704.01.**

Applicants submit that the previous Examiner, Examiner Cohen, indicated to Applicants that the present application would be in condition for allowance once the amendments to the claims discussed in the Interview of May 2, 2002 were submitted by Applicants. The claim amendments discussed in the Interview of May 2, 2002 were indeed submitted in the Supplemental Amendment date May 7, 2002. Moreover, the Office has not shown any evidence of clear error on either Applicants' part or Examiner Cohen's part.

With respect to an interview conducted by a previous Examiner, the M.P.E.P. states:

> **Sometimes the examiner who conducted the interview is transferred to another Technology Center or resigns, and the examination is continued by another examiner. If there is an indication that an interview had been held, the second examiner should ascertain if any agreements were reached at the interview. Where conditions permit, as in the absence of a clear error or knowledge of other prior art, the second examiner should take a position consistent with the agreements previously reached. See MPEP § 812.01 for a statement of telephone practice in restriction and election of species situations. MPEP § 713.01.**

Again, the Supplemental Amendment filed May 7, 2002 gives a clear indication that an interview had been held and that an agreement was reached which would place this application in condition for allowance. Furthermore, the Restriction Requirement, dated July 2, 2002 makes no indication of clear error on either the part of Applicants or Examiner Cohen. Moreover, the Restriction

Requirement gives no indication of other prior art. Accordingly, Applicants respectfully submit that the Restriction Requirement dated July 25 was improper and should be withdrawn.

Applicants submit that this application is in condition for allowance and early action in that regard is respectfully solicited.

If any additional fees are due in connection with the filing of this Response, such as fees under 37 C.F.R. §§ 1.16 or 1.17, the Commissioner is authorized to charge SGR Deposit Account No. 02-4300; Order No. 032405.061. Similarly, please credit any overpayment SGR Deposit Account No. 02-4300; Order No. 032405.061.

Respectfully submitted,

SMITH, GAMBRELL & RUSSELL, LLP

By: _____

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